

Notice of Allowability

Application No.

10/666,068

Examiner

Brian J. Davis

Applicant(s)

BUETTNER ET AL.

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to applicant's amendment (3/23/05).
2. ☒ The allowed claim(s) is/are 10-40 [renumbered 1-31].
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date attached.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

DETAILED ACTION

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Andrea Small on 5/9/05.

The application has been amended as follows:

In claim 16, the dependency has been changed from claim "13" to claim

-- 15--.

102 Rejections Withdrawn

The rejections of claims 1, 8 and 9 under 35 USC 102(b), outlined in the previous Office Action, have been overcome by applicant's amendment. The amendment cancels the claims.

103 Rejections Withdrawn

The rejections of claims 1-9 under 35 USC 103(a), outlined in the previous Office Action, have been overcome by applicant's amendment. The amendment cancels the claims.

Claim Objections Withdrawn

The objection to claims 10-16, as being objected to because they depended from a rejected base claim but otherwise allowable, is withdrawn. Applicant's amendment recasts the pertinent claims within the group of 10-16 as independent claims.

Allowable Subject Matter

Claims 10-40 are allowed. The following is an examiner's statement of reasons for allowance:

The closest prior art appears to be US 3,657,244, prior art of record. The reference teaches a set of the instant compounds within a larger set of structurally related compounds which exhibit bronchospasmolytic and antipruritic activities and that

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dilate the peripheral blood vessels in warm-blooded animals such as mice and rats (column 12 line 72). The cited prior art neither teaches nor suggests, however, the instant methods (treatment of asthma, COPD, tocolysis, etc.) or compositions. Nor would it have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of the prior art in order to arrive at those of the instant invention. There is no motivation to do so.

At best, it might have been obvious to try the prior art compounds in the treatment of asthma, COPD, tocolysis, etc., however, an 'obvious to try' standard is impermissible in two situations: 1) where the prior art gives no indication as to which of numerous parameters are critical, or gives no indication as to which of many possible choices is likely to be successful; and 2) where the prior art gives only general guidance with respect to the form of the invention but not how to achieve it new areas of technology or in fields of experimentation which are only seemingly promising. *In re O'Farrell*, 853 F2d 894, 7 USPQ 2d 1673, 1681 (Fed. Cir. 1988). In the instant case, both 1 and 2, above, apply.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


BRIAN DAVIS
PRIMARY EXAMINER

Brian J. Davis
May 9, 2005